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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/578,623

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EXAMINER

PEPITONE, MICHAEL F

ART UNIT

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1796

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/578,623	Applicant(s) SANAI, YASUYUKI	
	Examiner MICHAEL PEPITONE	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-24 and 27 is/are rejected.
- 7) ☒ Claim(s) 25, 26 and 28 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 5-15 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukushima et al (US 5,969,867).

Regarding claims 5-13, Fukushima et al teach an active ray-curable composition (Abstract) comprising an active energy ray-sensitive radical polymerization initiator (5:4-5) {photoinitiator}, bis(4-(meth)acryloyldiethoxyphenyl) sulfide (6:46-47), and 2-phenylphenyl(meth)acrylate (8:2) {o-phenylphenyl acrylate}. Regarding the weight percent limitations of instant components (A) and (B), Fukushima et al teach the composition comprising 10-90 parts by weight of instant structure (1) (7:3-5), wherein instant structure (1) is equivalent to reference component (B-1)) and 1-50 parts by weight of instant structure (2) (8:15-17, wherein instant structure (2) is equivalent to reference component (B-2)). The selection of bis(4-(meth)acryloyldiethoxyphenyl) sulfide as reference component B-1 and 2-phenylphenyl(meth)acrylate as reference component B-2 would have been easily envisioned by one of ordinary skill in the art, given the disclosure.

Regarding claim 14, Fukushima et al teach the cured composition having a refractive index of 1.62 or higher (9:39), however the reference is silent to the temperature at which the

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refractive index is measured. Additionally, the reference teaches the refractive index of equivalent compositions being higher than 1.62 at 20°C (Table 2 Ex. 8, 9, 11, 12 & 13, 10:64).

The Office realizes that all the claimed effects or physical properties are not positively stated by the reference. However, the reference teaches all of the claimed reagents and was prepared under similar conditions. Therefore, the claimed effects and physical properties, i.e. a refractive index of 1.59 or higher at 25 °C, would implicitly be achieved by a composition with all the claimed ingredients. If it is the applicants' position that this would not be the case: (1) evidence would need to be presented to support applicant's position; and (2) it would be the Office's position that the application contains inadequate disclosure that there is no teaching as to how to obtain the claimed properties and effects with only the claimed ingredients.

Regarding claim 15, Fukushima et al teach the active energy ray-curable composition as a lens sheet (Abstract).

Regarding claim 27, Fukushima et al teach bis(4-(meth)acryloyldiethoxyphenyl) sulfide (6:46-47), and 2- phenylphenyl(meth)acrylate (8:2) {o-phenylphenyl acrylate}. Bis(4-(meth)acryloylethoxyphenyl) sulfide is anticipated from general formula II (5:50-15) with $m = 1$.

Claims 16-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukushima et al (US 5,969,867).

Regarding claims 16-24, Fukushima et al teach a method for producing a lens sheet comprising casting an active energy ray-curable composition into a lens mold and irradiating for curing (9:7-16). Furthermore, Fukushima et al teach an active ray-curable composition (Abstract) comprising an active energy ray-sensitive radical polymerization initiator (5:4-5)

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{photoinitiator}, bis(4-(meth)acryloyldiethoxyphenyl) sulfide (6:46-47), and 2-phenylphenyl(meth)acrylate (8:2) {o-phenylphenyl acrylate}. Regarding the weight percent limitations of instant components (A) and (B), Fukushima et al teach the composition comprising 1-90 parts by weight of instant structure (1) (7:3-5, wherein instant structure (1) is equivalent to reference component (B-1)) and 1-50 parts by weight of instant structure (2) (8:15-17, wherein instant structure (2) is equivalent to reference component (B-2)). The selection of bis(4-(meth)acryloyldiethoxyphenyl) sulfide as reference component B-1 and 2-phenylphenyl(meth)acrylate as reference component B-2 would have been easily envisioned by one of ordinary skill in the art, given the disclosure.

Response to Arguments

The Declaration under 37 CFR 1.132 filed 5/4/09 is insufficient to overcome the rejection of claims based upon Fukushima et al (5,969,867) as set forth in the last Office action because: While showing unexpected results over a composition comprising MPSMA compound, the declaration is silent with regards the bis(4-(meth)acryloyloxydiethoxyphenyl) sulfide and/or other sulfide compounds that are represented by formula II {component (B-1) of Fukushima et al (US 5,969,867)} and found in column 6, i.e., compounds that are closest in structure to applicant's claimed invention. The MPSMA while having a sulfide linkage between the phenyl rings also has sulfur moieties linking the (meth) acrylic groups to said phenyl groups. Therefore it is deemed the similarities between the claimed formula (1) and the MPSMA of the claims stops at the phenylene linkage. Applicant appears to be relying on the declaration comparing MPSMA from the reference to the BAPS of the claims. Applicant argues that they only need to

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compare the claimed invention to the closest specific example in the prior art (or a closer embodiment) and submit the Declaration does such. This is not persuasive since applicant did not compare the "closer" embodiment of the invention, which would be as suggest by Examiner Treidl, i.e., an example where B-1, as taught by the reference is the bis(4-(meth)acryloyloxydiethoxyphenyl) sulfide and/or other sulfide compounds that are represented by formula II and found in column 6. Therefore the rejections still stand. As such, the Declaration is not commensurate in scope with closest prior art of record {Fukushima et al (US 5,969,867)}.

Allowable Subject Matter

Claims 25-26 and 28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: Fukushima et al (US 5,969,867) fails to disclose *p*-cumylphenyl acrylate as component (B-2) (7:14-8:27).

Baba et al. (JP 09-235338) {English machine translation was used} discloses an alkoxylated {ethoxylated} *p*-cumylphenyl acrylate (having 1 to 5 alkylene oxide units {ethylene oxide} {n = 1 to 5} appended between the (meth)acryl moiety and *p*-cumylphenol moiety {claim 1, ¶ 5-8}. Baba et al. (JP 09-235338) does not teach or suggest *p*-cumylphenyl acrylate {having zero ethylene oxide units {n = 0} appended between the (meth)acryl moiety and *p*-cumylphenol

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moiety. Modification of ethoxylated *p*-cumylphenyl acrylate to afford *p*-cumylphenyl acrylate {n = 0} would be based on improper hindsight reconstruction of the claims.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL PEPITONE whose telephone number is (571)270-3299. The examiner can normally be reached on M-F, 7:30-5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on 571-272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MFP
11-September-09

/Mark Eashoo/
Supervisory Patent Examiner, Art Unit 1796